

**REMARKS**

**I. Status of th Claims**

Claims 1-56 are pending in this application. Claims 4 and 27-29 are subject to a restriction requirement and have been withdrawn from consideration. Claims 8 and 35 have been amended to remove a duplicative compound. Claim 52 has been amended to correct the dependency of this claim. Accordingly, no new matter has been added nor has the scope of the claims been narrowed.

**II. Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 8, 9, and 25 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention for the reasons set forth on page 3 of the present Office Action. Applicants respectfully traverse this rejection.

Applicants thank the Examiner for pointing out the duplicative recitation in claim 8 and have accordingly amended claims 8 and 35 to remove "N-oleoyldihydrosphingosine." Accordingly, Applicants respectfully request withdrawal of the rejection of claims 8 and 9.

The Examiner asserts that the phrase "protein derivatives" renders claim 25 vague. See page 3 of the present Office Action. Applicants respectfully traverse this reason for rejection.

In order to meet the requirements of 35 U.S.C. § 112, second paragraph, the claims of an application must define the patentable subject matter with a reasonable degree of particularity and precision. M.P.E.P. § 2173.02. The Federal Circuit has

decided that the definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.* Further, breadth is not indefiniteness under § 112, second paragraph. M.P.E.P. § 2173.04.

Applicants respectfully submit that one of ordinary skill in the art would understand what is meant by the term "derivatives" as used in the present application and would therefore understand the metes and bounds of the presently claimed invention. When properly analyzed in light of all the claim language, the content of the specification, and the teachings of the prior art, the term "derivatives" clearly defines the subject matter that Applicants consider within the scope of their invention with reasonable particularity and precision.

In support of their position, Applicants submit herewith p. 375 from The American Heritage College Dictionary (Third Edition), which defines the noun "derivative" as "[a] compound derived or obtained from another and containing the essential elements of the parent substance," and defines the verb "derive" as "[t]o produce or obtain (a compound) from another substance by chemical reaction."

Thus, claim 25 which recites that "protein derivatives" is not indefinite. In contrast, this claim reasonably conveys that the at least one adjuvant may be chosen from compounds derived or obtained from proteins and containing the essential elements of the parent protein.

Accordingly, Applicants respectfully assert that, in light of the language of all the claims, the specification, and the teachings of the prior art, what is meant by the term

"derivatives" is clear. Accordingly, Applicants respectfully submit that this reason for rejection is in error and request that this rejection be withdrawn.

### III. Rejections Under 35 U.S.C. § 102

Claims 50-52 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 97/15271 ("*Laurent*") as understood by U.S. Patent No. 6,251,378 for the reasons set forth on pages 3-4 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner states that *Laurent* discloses a composition and method for oxidation dyeing of keratin fibers and that a subject of the invention is a multi-compartment kit, a first compartment of which contains a dye composition, and a second compartment which contains the oxidizing composition. See page 4 of the present Office Action. According to the Examiner, Example 2 of *Laurent* is comprised of N-oleoydihydrosphingosine and hexadimethrine chloride as part of the common dye support. *Id.* Applicants respectfully disagree.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. §§ 706.02(a), 2131 ("For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

Example 2 of *Laurent* is a dye composition comprising N-oleoydihydrosphingosine in an oxidation dye composition. See col. 9, lines 1-22 reciting that N-oleoydihydrosphingosine is comprised within a composition also

comprising para-phenylenediamine (an oxidation base), meta-aminophenol (a coupler), and common dye support. In contrast, the multi-compartment kit of claims 50-52 comprise two separate compartments: a first compartment containing a composition comprising at least one compound chosen from ceramides and glycoceramides, and a second compartment containing a composition for chemical treatment of keratinous fibers, e.g., a dyeing composition. In other words, unlike *Laurent*, the at least one compound chosen from ceramides and glycoceramides is in a different compartment from the chemical treatment. Thus, for at least this reason, *Laurent* does not expressly or inherently describe the multicompartment kit of claims 50-52. Accordingly, Applicants respectfully request the withdrawal of this rejection.

#### IV. Rejections Under 35 U.S.C. § 103

Claims 1-3, 5-26 and 50-52 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Laurent* (above) as understood by U.S. Patent No. 6,251,378 in view of U.S. Patent No. 5,656,258 to Cauwet et al ("*Cauwet*") for the reasons set forth on pages 5-6 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner contends that it would have been obvious to have modified the compositions of *Laurent* by the addition of the MERQUAT 280 of *Cauwet*. See page 6 of the present Office Action. Applicants disagree.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. Recently, the Federal Circuit asserted that:

~~[t]he factual inquiry whether to combine references must be thorough and searching. It **must be based on objective evidence of record** . . . . [T]he Board must not only assure that the requisite findings are made, based on evidence of record, but **must also explain the reasoning** by which the findings are deemed to support the agency's conclusion.~~

See In re Lee, 61 U.S.P.Q.2D (BNA) 1430 (Fed. Cir. 2002) (emphasis added). In the present case, the Examiner has failed to make a factual inquiry based on objective evidence of record. Such an inquiry would reveal that there would have been no motivation to make the proposed modification.

The Examiner argues that one of ordinary skill in the art would have been motivated to combine *Laurent* and *Cauwet* in order to benefit from the synergistic effect of the combined polymers for improving the disentanglement of hair as taught by *Cauwet*. However, the compositions of *Laurent* are for use in the oxidation dyeing of keratin fibers. In contrast, there is no mention in *Cauwet* of oxidation dyeing. Rather, *Cauwet* is drawn to cosmetic compositions for the hair and the skin containing conditioning polymers. See col. 1, lines 4-6. Thus there would have been no motivation to use the compositions of *Cauwet* in an oxidation dyeing composition. At most, such a modification might have been obvious to try. This, however, is not sufficient to maintain a rejection under § 103. Further, the Examiner has not provided any objective evidence that would have led one of ordinary skill in the art to make such a modification as required by In re Lee.

To establish a *prima facie* case of obviousness, there must also be a reasonable expectation of success. See M.P.E.P. § 2143. However, the requisite reasonable

expectation that the desired properties of *Cauwet* would be present in an oxidation dyeing environment is not present. The art of oxidation dye compositions is highly unpredictable and the chemical environment of such a composition varies greatly from a composition for hair conditioning. Further, the Examiner has not provided any objective evidence that would have led one of ordinary skill in the art to have a reasonable expectation of success.

Applicants respectfully submit that a *prima facie* case of obviousness has not been made because the documents fail to provide either a motivation to combine reference teachings and a reasonable expectation of success for making the proposed modification. Accordingly, for at least the foregoing reasons, Applicants respectfully request the withdrawal of this § 103(a) rejection.

## V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of the pending claims and reexamination of the application. The timely allowance of the pending claims is respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

*Shalia V. Wanneret*, Reg No. 39,064

By: *for Anthony C. Tridico*  
Anthony C. Tridico  
Reg. No. 45,958

Dated: May 22, 2002

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Appendix

Version with markings to show changes made pursuant to 37 C.F.R. § 1.121(c)(1)(ii):

8. A composition according to claim 1, wherein said at least one compound chosen from ceramides and glycosphingolipids is chosen from:

- N-linoleoyldihydrosphingosine,
- [- N-oleoyldihydrosphingosine,]
- N-palmitoyldihydrosphingosine,
- N-stearoyldihydrosphingosine,
- N-behenoyldihydrosphingosine,
- N-2-hydroxypalmitoyldihydrosphingosine,
- N-stearoylphytohydrosphingosine,
- 2-oleamido-1,3-octadecanediol, and
- N-palmitamidohexadecanediol.

35. (Amended) A process according to claim 27, wherein said at least one compound chosen from ceramides and glycosphingolipids is chosen from:

- N-linoleoyldihydrosphingosine,
- [- N-oleoyldihydrosphingosine,]
- N-palmitoyldihydrosphingosine,
- N-stearoyldihydrosphingosine,
- N-behenoyldihydrosphingosine,
- N-2-hydroxypalmitoyldihydrosphingosine,
- N-stearoylphytohydrosphingosine,

- 2-oleamido-1,3-octadecanediol, and
- N-palmitamidohexadecanediol.

52. (Amended) A multi-compartment kit according to claim 50 [51], wherein said composition comprising at least one compound chosen from ceramides and glycosceramides further comprises at least one polymer chosen from at least one cationic polymer and at least one amphoteric polymer.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com



THE  
AMERICAN  
HERITAGE®  
COLLEGE  
DICTIONARY

---

THIRD EDITION



HOUGHTON MIFFLIN COMPANY

*Boston • New York*

**Stress marks:**  
' (primary);  
' (secondary), as in  
dictionary (dīk 'shə-nēr'ē)

**Stress marks:**  
' (primary);  
' (secondary), as in  
dictionary (dīk 'shə-nēr'ē)